



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,912	06/09/2000	Douglas Corning	SCHW-410	3491

29585 7590 06/17/2003

GRAY CARY WARE & FREIDENRICH LLP  
153 TOWNSEND  
SUITE 800  
SAN FRANCISCO, CA 94107

EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/591,912

Applicant(s)

CORNING ET AL.

Examiner

Stefano Karmis

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

The following application has been reviewed. Original claims 1-37 are pending. Any objections and rejections are stated below:

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-4, 6-10, 12-15, 17, and 19-21 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Martyn et al. (hereinafter Martyn) U.S. Patent 6,195,647,671.

Referring to claim 1, Martyn discloses a data processing system that monitors financial securities to provide information to a user (abstract). The information is being tracked in a workstation, which is capable of exchanging information with a central computer (column 4, lines 18-25). The workstation maintains a data list of all the items to be monitored (abstract). The data list may be broken down into groups with certain labels and then can be displayed such as items tagged in the foreign market or the domestic market (column 6, lines 8-21).

Art Unit: 3624

Claims 3 and 17, the data processing system of Martyn monitors securities for users (abstract).

Claims 4 and 15, the data processing system monitors securities and displays them on a personal workstation device (column 3, line 60 thru column 4, line 11).

Claim 6-8 and 19-21, Martyn displays a running total of the items selected as well as the maximum amount desired by a user (column 7, lines 3-18).

Claims 9 and 10, adding a new security to be monitored simply requires entering an identifier for that particular security and the security will be tagged depending on the type of security selected (column 5, line 62 thru column 6, line 21).

Claim 12, the display shows selected information provided by the central computer regarding the securities being monitored, such as price quotes (Figure 4).

Regarding claim 13, all of the items in the data list are displayed on the personal computing device (column 7, lines 3-18).

Claim 14, Martyn discloses a system in which information relating to the items being monitored is maintained in a data list and also possesses a classification tag (column 5, line 62 thru column 6, line 21). A central computer is capable of exchanging with the workstation

information pertinent to the securities being monitored (column 4, lines 18-25). The display shows selected information provided by the central computer regarding the securities being monitored along with their classification tag, such as price quotes (Figure 4).

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 2, 5, 11, 16, 18, and 22-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martyn et al. (hereinafter Martyn) U.S. Patent 6,195,647/671 in view of Bushner et al. (hereinafter Bushner) U.S. Patent 6,462,671.

Regarding claim 2, 18, 26 and 34, Martyn teaches a system that allows for the monitoring of securities based on selections from the user. Martyn fails to teach the step of limiting the number of items being monitored to a predetermined number. Official Notice is taken that setting a limit on the number of items to be monitored is old and well known in the art. Therefore it would have been obvious to anyone of ordinary skill in the art at the time of the Applicant's invention to modify the teaching of Martyn and allow for a limit because it provides further guidelines and helps to display the items in a more standard readable format.

Claims 5, 16, 24, and 32, Martyn fails to teach accessing the information from a hand held device. Bushner teaches an interlink system for conveying security to hand held devices. Therefore it would have been obvious at the time of the Applicant's invention that the teachings of Martyn could be modified to include transmitting the monitored items to a hand held device as taught by Bushner because it allows for users to have real time information on securities regardless of their travels.

Claim 11, Martyn teaches the ability to delete security items being watched. Martyn does not teach a predetermined number of securities to be selected and therefore does not require that to add a security to be monitored, another one must be deleted. Official Notice is taken that adding and deleting items in a list is old and well known in the art. It would have been obvious at the time of the Applicant's that the teachings of Martyn could be modified to required deleting a security being monitored when one is added because a predetermined number is set and by adding a security another one would have to be deleted to stay on that predetermined number.

Claims 22 and 30, Martyn teaches a system and software program in which information relating to the items being monitored is maintained in a data list and also possesses a classification tag (column 5, line 62 thru column 6, line 21). A central computer is capable of exchanging with the workstation information pertinent to the securities being monitored (column 4, lines 18-25). The display shows selected information provided by the central computer regarding the securities being monitored along with their classification tag, such as price quotes (Figure 4).

Martyn fails to teach that the user supplies the classification tags. Official Notice is taken that user defined tags are old and well known in the art. It would have been obvious at the time of the Applicant's invention to modify the tagging method to allow for users to supply the tag because it allows for user to name the monitored items in a manner well known and recognizable to that individual.

Claims 25 and 33, the data processing system of Martyn monitors securities for users (abstract).

Claims 23, and 31, the data processing system monitors securities and displays them on a personal workstation device (column 3, line 60 thru column 4, line 11).

Claim 27-29 and 35-37, Martyn displays a running total of the items selected as well as the maximum amount desired by a user (column 7, lines 3-18).

*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Parsons US Patent 4,486,853. Dec. 4, 1984. Apparatus for receiving and displaying continuously updated data.
- b) Kosaka et al. US Patent 5,161,103. Nov. 3, 1992. Real time status monitoring system.
- c) Broka et al. US Patent 5,809,483. Sep. 15, 1998. Online transaction processing system for bond trading.
- d) Nevo et al. US Patent 5,946,666. Aug. 31, 1999. Monitoring device for financial securities.
- e) Eischstaedt et al. US Patent 6,381,594. Apr. 30, 2002. System and method for personalized information filtering and alert generation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and for After Final communications.



Application/Control Number: 09/591,912  
Art Unit: 3624

Page 8

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

Respectfully Submitted  
Stefano Karmis  
June 12, 2003



**HANI M. KAZIMI**  
**PRIMARY EXAMINER**